

REMARKS / ARGUMENTS

Reconsideration of the application as amended is respectfully requested.

The examiner respectfully rejected:

- Claim 1-3 under U.S.C. § 103(a) as being unpatentable over Moore et al. in view of Spector,
- Claims 9-13 under U.S.C. § 103(a) as being unpatentable over Moore et al. in view of Spector and further in view of Romero, Jr.,
- Claims 1-3 and 9-12 under U.S.C. § 103(a) as being unpatentable over either Moore et al. or Romero, Jr., in view of Spector,
- Claims 4-8 under U.S.C. § 103(a) as being unpatentable over either Moore et al. or Romero, Jr., in view of Kumasaka.

To summarize each of the cited references:

Moore et al discloses a post-guard cover to cover the jagged edges of exposed poses of a vehicle that has had the roof removed.

Spector does not disclose a cover at all, but discloses a play ball in which a flexible casing encloses a toy balloon, and that can convert into a carrying case.

Romero, Jr. et al discloses an exhaust pipe cover.

And, Kumasaka discloses a liquid fuel burning torch itself of the type that the present invention is intended to function as a cover for.

With the possible exception of Kumasaka, there references appear to be nonanalogous art unrelated to the present invention. Two criteria have evolved for determining whether prior art is

analogous: (1) whether the art is from the same field of endeavor, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. A reference is reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem. If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, . . . [i]f it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it. In re Clay, 23 USPQ 2d 1058, 1060-61 (Fed. Cir. 1992) Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. The prior art of record fails to provide any such suggestion or incentive. ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 USPQ 929, 932, 933 (Fed. Cir. 1984)

Based upon the above arguments, it is felt that the differences between the present invention and all of these references are such that rejection based upon 35 U.S.C. § 103, in addition to any other art, relevant or not, is also inappropriate. However, by way of additional argument applicant wishes to point out that it is well established at law that for a proper *prima facie* rejection of a claimed invention based upon obviousness under 35 U.S.C. § 103, the cited references must teach every element of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination. See Orthopedic Equipment Company, Inc. et al. v. United States, 217

USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, "Monday Morning Quarter Backing is quite improper when resolving the question of obviousness." Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

There is no suggestion as to the desirability of any modification of the references to describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. When the prior art references require a selective combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself.

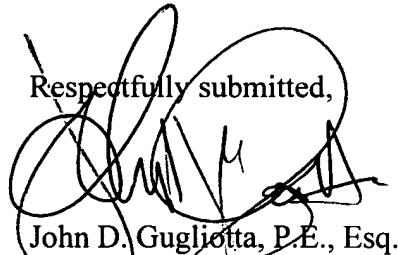
• Interconnect Planning Corp v. Feil, 774 F.2d 1132, 227 USPQ 543 (CAFC 1985). There is nothing in the prior art or the Examiners arguments that would suggest the desirability or obviousness of making a torch cover having an upper housing with a upper cover at one end, an orifice at an opposite end, having a drawstring, conduit and retention means, and having an internal retention volume adapted to securely fit over a torch and protect the material from which the torch is made from the environmental elements. Uniroyal, Inc. v. Rudkki-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1432 (CAFC 1988). The examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention. However, there must be a reason or suggestion in the art for selecting the design, other than the knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ 2d 1529 (CAFC 1988); see also In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (CAFC

1988).

To summarize, it appears that only in hindsight does it appear obvious to one of ordinary skill in the pertinent art to combine the present claimed and disclosed combination of elements. To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (CAFC 1986); In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (CAFC 1988).

Therefore, in view of foregoing amendments and clarifications, the applicant submits that allowance of the present application and all remaining claims, as amended, is in order and is requested.

Respectfully submitted,



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